

No. 11652

IN THE

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

LEROY J. LEISHMAN,

Appellant,

vs.

RADIO CONDENSER COMPANY and GENERAL INSTRUMENT
CORPORATION,

Appellees.

RADIO CONDENSER COMPANY and GENERAL INSTRUMENT
CORPORATION,

Cross-Appellants,

vs.

LEROY J. LEISHMAN,

Cross-Appellee.

DEFENDANT-APPELLANT'S SUPPLEMENTAL
BRIEF.

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I.

Introduction.

The questions of the Honorable Judge Bone regarding the finality of the decision of the Patent Office in granting a reissue, which were asked at the hearing on the appeal, were particularly pertinent because of the statement in this Court's opinion in the *Associated* case that if the claims of the reissue patent "do not include levers,

the claims are not for the same invention as the original patent and hence are invalid. If they do include levers, the claims are not infringed, for the accused device contains no lever.”

Despite this statement, the opinion nevertheless went on to consider whether the plungers and levers were equivalents. Inasmuch as the opinion had just previously said that the reissue claims are not for the same invention as the original unless they include levers, the subsequent consideration of this subject of equivalency seemed to mean that the claims would nevertheless be infringed if the plungers and levers were equivalents. Otherwise, there was no apparent pertinence in considering whether they were equivalents and in the holding that they were not. Because of the controlling significance thus apparently attached to this matter when the *Associated* decision was rendered, the patentee proceeded in the present action to establish infringement by introducing evidence, not previously before the court, proving that plungers and levers have long been known as proper substitutes in this art and that they meet the requirements for mechanical equivalents made by the Supreme Court.

It is now clear, however, that it is advisable to consider whether the reissue claims need to include levers in order to be for the same invention as the original patent. In this connection, the defendant appreciates the helpful remark which the Honorable Judge Matthews made at the hearing to the effect that if all the present evidence as to the equivalency of plungers and levers had been in the *Associated* record, it would not have made the slightest difference in his opinion, but that he could not speak for his colleagues.

The consideration of the equivalency of levers and plungers at the close of the *Associated* decision thus apparently had nothing to do with the formulation of the Honorable Judge Matthews' individual opinion in that case. The holding that these elements are not equivalents nevertheless forms part of the total opinion of this Court as it appears in the published decision, and this issue therefore cannot safely be ignored by any litigant in any action where the *Associated* opinion might apply.

The hearing thus showed that two questions must be considered on the matter of infringement: whether plungers and levers are equivalents, and whether the re-issue claims need to include levers in order to be for the same invention as the original patent. For reasons hereinbefore stated, the latter question was given little consideration in defendant's previous briefs; but the interest shown by the Court in this aspect of the case at the hearing makes it advisable that the subject be more thoroughly treated in connection with the pertinent decisions.

In view of the statement of the Honorable Judge Orr that the defendant could safely assume that the court would like additional information on all the issues, certain other subjects will also be concisely treated. The pendency of another case in this circuit, and the appeal now before the Tenth Circuit Court of Appeals, both involving this same patent, makes it particularly important that this court be well informed on the pertinent law when deciding the issues now before it.

II.

The Scope of the Summary Judgment.

As stated on the first page of the patent here in suit [R., Vol. II, p. 169, column 1, lines 30 to 33], one of the objects of defendant's invention is "to afford means whereby the apparatus *may easily be adjusted* so that a definite manual operation will cause the desired rotatable element [radio tuning dial] to be turned to a desired position." This involved the overcoming of unexpected problems and unobvious difficulties discussed at length in the briefs on the issue of validity in the *Associated* case. This appeal is not concerned with these problems and their solution, because plaintiffs' Motion for Summary Judgment asked for a decision on the question of infringement only. Suffice it to say, however, that these difficulties were overcome by constructing and arranging the rocker and tappet so that their axes of rotation are coincident or in line (coaxial) when these two members are in complete engagement, as illustrated and described in the original and reissue patents.

Such a rocker and tappet combination, plus a spring for moving the tappet away from the rocker, *are the only elements called for in claims 7 and 8*, which cover the very heart of the invention. No lever or plunger or other operating member is mentioned in these two claims, because it manifestly makes no difference how the tappet is moved into engagement with the rocker.

This basic combination is admittedly present in plaintiffs' tuners, but the summary judgment was requested in order to determine whether the plaintiffs can appropriate this combination and avoid infringement of *all* the claims simply by using a plunger as the "manually operable means" or "manually operable member" called for in claims 9, 10 and 11.

III.

Re the Equivalency of the Plungers and Levers.

In view of opposing counsel's recent concession that plungers and levers were both old in the radio tuning art, only a few more points need now to be cleared up on the subject of equivalency before passing on to a discussion of whether the reissue claims must include levers in order to be for the same invention as the original patent.

When the defendant was discussing the evidence of the equivalency of plungers and levers at the hearing, the Honorable Judge Bone asked about the use of plungers in this particular art. When the defendant mentioned the 1883 device of Kettell, shown on the insert between pages 36 and 37 of Appellant's Opening Brief, Judge Bone inquired as to the pertinence of this to the automatic tuning of a radio receiver. The defendant wishes to point out that the Kettell device, which is disclosed more fully in the patent itself in Vol. II beginning on page 178, was an electric clock setting mechanism, intended for the specific purpose of bringing the minute hand exactly to the perpendicular position in line with the figure 12 in response to an electrical impulse. This is the same general problem as that with which we are concerned in turning a radio tuning dial to a specific position. With Kettell's clock, however, the angular position to which the minute hand must be turned was always the same, whereas an automatic tuner must be capable of advance adjustment so that the plunger or lever will rotate the dial or knob to the particular angular position required for whatever station the user may desire.

Regarding this more specific field, the Honorable Judge Bone asked what prior art patents showed the use of plungers in devices intended for tuning radio sets. The following list shows the *tuner* patents in Volume II of the present record that disclose the use of plungers, together with the figures in which the plungers may be seen, and the reference numbers by which the plungers may be identified:

- Bast, p. 186, Fig. 2, plunger 12;
- Marvin, p. 190, Fig. 1, plungers 2, 3, 4, 5, 6 and 7;
- Freytag, p. 204, Figs. 1, 4 and 5, plunger 15;
- Faas, p. 212, Figs. 1, 2, 3 and 4, plunger 39;
- Jacke, pp. 228 and 229, Figs. 1, 2, 3, and 8, plunger 11;
- Peck, p. 238, Fig. 2, plunger 30;
- Danish patent, p. 255, Fig. 1, plungers 3 and 6.

All the patents in the foregoing list were issued before the patent at issue was granted, except that of Jacke; but Jacke's use of plungers was well known in the art because of the many interferences in which it became involved in the patent office before the issuance of defendant's patent.

The Kettell patent, previously discussed, and the Peck and Danish patents on the foregoing list, each illustrate the *alternative* use of plungers and levers in the same device. The pertinent figures from the Kettell, Peck and Danish patents were reproduced in Appellant's Opening Brief.

Plungers were thus well known as proper substitutes for levers when the patent at issue was granted, and they are therefore mechanical equivalents of levers according to the formula set forth and followed by the Supreme Court, quoted in the previous briefs.

Inasmuch as the opinion in the *Associated* case says the plungers and levers are *not* equivalents, the district courts in this circuit are not likely to hold otherwise until this Honorable Court corrects its ruling in accordance with the new evidence now before it.

Actually, of course, the essence of the invention is in the construction and arrangement of the rocker and tap-pet. A lever or plunger is merely a convenient means of operating the combination.

IV.

The Reissue Claims Do Not Have to Include Levers in Order to Be for the Same Invention as That Described in the Original Patent.

- (a) **Plungers Were Equivalents of the Levers in the Original Patent as Well as in the Reissue, and Since the Original Patent Was Thus Not Confined to Levers, the Reissue Does Not Have to Include Levers in Order to Be for the Same Invention.**

It was pointed out at the hearing that the specifications and drawings of the original and reissue patents are identical. It therefore follows that if plungers were well known as substitutes for levers before the issuance of the original patent, these elements must be regarded as mechanical equivalents in the original as well as in the reissue. Both patents issued in 1938—the original on February 15th and the reissue six months later on August 16th. All of the uses of plungers hereinbefore discussed antedated the original as well as the reissue. The original patent was therefore not confined to levers, and it consequently cannot be held that the reissue must be confined to levers in order to be for the same invention.

(b) The Law With Respect to Reissues.

At the hearing on this appeal, the Honorable Judge Bone inquired as to the finality of the decision of the Commissioner of Patents in granting a reissue. The law on this point was well stated by this Ninth Circuit Court of Appeals in its opinion in the case of *John Kitchen, Jr. Co. v. Levinson*, 188 F. R. 658, at 661:

“From the reissuance of the patent it is to be presumed that the law was complied with, and the proceedings can only be impeached for fraud. In *Seymour v. Osborne*, 11 Wall. 516-543 (20 L. Ed. 33), it was said:

“‘Where the commissioner accepts a surrender of an original patent and grants a new patent, his decision in the premises in a suit for infringement is final and conclusive and is not re-examinable in such a suit in the Circuit Court unless it is apparent upon the face of the patent that he has exceeded his authority, that there is such a repugnancy between the old and the new patent that it must be held as a matter of legal construction that the new patent is not for the same invention as that embraced and secured in the original patent.’”

The requirement that the reissue must be for the same invention as that embraced in the original, is made to prevent the patentee from introducing new matter into the reissue in order to secure claims that the original specification and claims would not support. But where a comparison of the two patents reveals that nothing new has been added, as in the present instance,

then the courts have held that the reissue is for the same invention as the original.

“Whether a reissue patent is for the same invention as that embodied in the original patent, or for a different one, is a question to be determined by a comparison of the two documents. It clearly appears, from an inspection of the drawings of the two patents here under consideration, that nothing new was added to the drawings of the reissue patent and that in the reissue specification the operation of certain elements was explained, which in the original was omitted. Both drawings fully support these conclusions. The inventions of the two patents are therefore identical. It is not new matter within the meaning of the statute, to explain, in a reissue, the operation of an element which was shown in the original drawing.” (*Hawie Mfg. Co. v. Hathaway*, 27 F. (2d) 937, 939.)

Even though the specifications in the *Hawie* case were altered to explain the operation of some of the elements, the court nevertheless held that the reissue was for the same invention because the drawings were the same. In the reissue with which we are concerned, no alteration whatever was made in either the drawings or the specifications, because no change of any kind was required in order to support the additional claims. These additional claims could have been made in the original patent itself. They merely described in more detail and with greater accuracy the construction of the rocker and its relationship with the tappet *as shown and described in the original patent*. They did not define the manually operable member as a lever, but neither did the objects of the *original* patent, nor *original* claim 5. In other words, the reissue

was for the same invention as that shown and described in the original.

One of the leading Supreme Court cases on reissues, is *Topliff v. Topliff*, 145 U. S. 156, 166, where the court said:

“* * * There is no doubt, as was said by this court in *Powder Company v. Powders Works*, 98 U. S. 126, 137, 138, that a reissue can only be granted for the same invention which formed the subject of the original patent, of which it is a reissue, since, as was said by the court in that case, the express words of the act are ‘a new patent for the same invention.’ The specification may be amended so as to make it more clear and distinct; the claim may be modified so as to make it more conformable to the exact rights of the patentee, but the invention must be the same . . . This prohibition is general, relating to all patents; and by ‘new matter’ we suppose to be meant new substantive matter, such as would have the effect of changing the invention, or of introducing what might be the subject of another application for a patent.”

The term “new matter,” mentioned in the foregoing Supreme Court case and in the previously quoted *Harvie* decision, is also mentioned in Rule 88 of the Rules of Practice of the U. S. Patent Office, which guides the patent office in seeing that reissues are in conformity with the statute and the controlling decisions. Rule 88 reads as follows:

“New matter shall not be allowed to be introduced into the reissue specification, nor in the case of a machine shall the model or drawings be amended except each by the other.”—*Rule 88, Rules of Practice of the U. S. Patent Office.*

In the reissue patent before the court, no new matter of any kind was introduced into the reissue specification, and the drawings were not amended in any respect whatever, and the claims were drawn to the same invention.

Two leading Supreme Court cases afford excellent illustrations of what can and cannot be done in reissue patents. One of these was *Topliff v. Topliff, supra*. It was there shown that the reissue patent may actually vary considerably from the original *so long as there is no change in substance*. Said the Supreme Court, at page 164:

“With regard to the reissue of this patent, the records show that on April 9, 1872, within four months from the date of the original patent, a reissue was granted, in which the specification was largely reframed, the drawings changed in form, though apparently not in substance, but the claim was changed only by providing that the connecting-rods should be ‘secured directly to the hind axle and front bolster,’ instead of ‘to the front and rear axles,’ as provided in the claim of the original patent . . .

* * * * *

“The original claim was, in the particular above mentioned, a clear mistake . . .

* * * * *

“The second reissue was applied for a little more than a month after the first was granted, although the patent was not granted upon this application until March 28, 1876, nearly four years after the application was filed. No change from the first reissue was made in the drawings or specification in this reissue, but the claim was divided and changed . . .

* * * * *

“* * * The second claim is to some extent a change of the claim of the first reissue. It omits the requirements that the connecting-rod shall be secured directly to the axle and bolster, so as to cause both ends of the side springs to yield simultaneously, and introduces the half elliptical springs AA' as a new element of the combination. Whether this be an enlargement of the original claim or not, it is for substantially the same invention, . . .

* * * * *

“* * * such reissues are subject to the following qualifications:

“First. That it shall be for the same invention as the original patent, *as such invention appears from the specification and claims of such original.*” (Emphasis added.)

If it is proper to make such changes as those approved by the Supreme Court in the *Topliff v. Topliff* decision, certainly the propriety of the present reissue cannot be questioned. The present reissue differed from the original only in the addition of seven claims, all of which were directed to the same invention disclosed in the specification and drawings of the *original* patent, which were adopted as the specification and drawings of the reissue *without the slightest change.*

New claims 7 and 8, which included only the rocker and tappet, were substantially like original claim 5, but claim 8 mentioned that the axes of the tappet and rocker must be coaxial when these two elements are in complete engagement, and claim 7 mentioned the recess in the rocker which helps to make the coaxial relationship possible.

The only other claims with which we are here concerned are claims 9, 10 and 11. These claims mentioned a "manually operable member" or "manually operable means" to move the tappet, and set forth structural features having to do with the coaxial relationship between the rocker and tappet.

Everything called for in these reissue claims pertained to the same invention shown and described in the *original* patent. They are thus manifestly for the same invention.

In *U. S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corporation*, 315 U. S. 668, 62 S. Ct. 939, the invention covered by the reissue was clearly not the invention set forth in the original, and the Supreme Court so ruled. In the original patent, the addition of water in the form of liquid or steam was stressed as an essential step in the chemical process that was patented. After the issuance of the original patent, further investigation led to a *new* discovery—namely, that the amount of moisture normally in the air was sufficient to make the addition of water in either form unnecessary. A reissue was then applied for, and the specification was entirely changed to include the new discovery. This was obviously the introduction of new matter, which the law forbids.

The reissue dealt with in the *U. S. Industrial Chemicals* case provides an excellent example of the kind of reissue which the Supreme Court said would provide an exception to its rule that the commissioner's decision is final. In the *Seymour v. Osborne* decision, quoted by the present court in the *John Kitchen* case, *supra*, the Supreme Court said the commissioner's decision "is final and conclusive and not re-examinable . . . unless it is apparent upon the face of the patent that he has exceeded his authority,

that there is such a repugnancy between the old and the new patent that it must be held as a matter of legal construction that the new patent is not for the same invention as that embraced and secured in the original patent."

So that the present court may see just what was thought to constitute such a "repugnancy between the old and the new patent" when the Supreme Court examined the original and reissue in the *U. S. Industrial Chemical* case, copies of the original and reissue patents have been provided in the appendix hereto as Exhibits A and B, respectively. They are so different that almost anyone would be likely to conclude that any resemblance is purely coincidental.

After examining the original and reissue patents in that case, with their very dissimilar specifications, the Supreme Court said:

"* * * The District Court made no finding directed to this fact, but the court below definitely holds, and we agree, that in the process defined in *the original patent*, the voluntary introduction of water into the reaction chamber is *mandatory*. * * *

"As the Circuit Court of Appeals held, the original specification and claims treated the voluntary introduction of water into the reaction chamber as a *necessary* step in the process, whereas such introduction is made *permissive* by the reissue. We agree with that court's view that there is thus a difference between the procedure described in the two documents.

* * *

“We think it plain that the reissue omitted a step in the process which was described and claimed as *essential* in the *original* patent.” (*U. S. Industrial Chemicals v. Carbide & Carbon C. Corp.*, 315 U. S. 668, 62 S. Ct. 839.) (Emphasis supplied.)

In the instant case, the use of a lever was not “described and claimed as essential in the original patent.” For the very reason that it was *not* essential, the patentee used the term *lever* in his original specification proper only when he was describing the illustrative embodiment shown in the drawings. In all other parts of the explanation he used terms sufficiently broad to include the mechanical equivalents that were well known in the art. That the patentee regarded the manner of moving the tappet as *immaterial* is shown in the objects, where the operation of the tuner is referred to *five different times* in broad enough terms to include *any* manner of operation. On page 1, column 1, lines 19 and 20 of the original patent [R., Vol. II, p. 175], the term is “a simple manually operated control.” In the same column, line 23, the reference is to “a single manual operation.” This same term recurs in lines 28 and 29. In lines 31 and 32, it is “a definite manual operation.” In the next column, line 8, in referring to the use of his invention for tuning in both sound and television, the patentee again uses the term “a single manual operation.”

That the patentee did not regard any particular kind of an operating member as essential is shown conclusively by original claim 5, *which did not even mention any kind of an operating means as an element of the combination.*

(c) In Examining the Original Patent for Evidence of What the Inventor Intended to Patent, This Honorable Court Should Have Considered Claim 5.

As set forth by the Supreme Court in its *Topliff v. Topliff decision, supra*, the reissue must be “for the same invention as the original patent, as such invention appears from the specification *and claims* of such original.” (Emphasis supplied.)

Claim 5 of the original patent did not include a lever, but was confined to the essential elements—the rocker and the pivoted tappet means, plus a spring for moving the tappet out of engagement with the rocker.

In the *Associated* case, however, this Honorable Court said: “No leverless combination is disclosed or claimed in the original patent” (137 F. (2d) at p. 726, but it explained in footnote 12 (at page 725), “For reasons heretofore stated the patent is construed as if claim 5 had never been included therein.”

After thus explaining that claim 5 would be omitted, the *Associated* decision quoted the other original claims—1, 2, 3, 4 and 6, and then stated: “No leverless combination is disclosed or claimed in the original patent” The opinion then quoted the claims added by the reissue and said: “If they do not include levers, the claims are not for the same invention as the original patent and hence are invalid.¹⁵ If they do include levers, the claims are not infringed, for the accused device contains no lever.” (Footnote 15 merely referred to the U. S. Industrial Chemicals decision, already discussed herein, and which was to the effect that a reissue patent may not omit something which was stressed as essential in the original.)

The opinion then proceeded to discuss whether the equivalents of defendant's structure could be found in the accused device; and after finding an equivalent rocker and tappet, the opinion concluded the discussion of equivalents by saying “. . . the plungers and the levers are not equivalents.”

From the helpful remarks made by the Honorable Judge Matthews at the hearing, it appears that despite the new evidence that plungers and levers *are* equivalents, some significance is nevertheless still being attached to the matter of whether the original patent defined a combination without levers. The defendant therefore proposes to show that claim 5, though later disclaimed, should not have been omitted when examining the original claims for evidence of the patentee's intent.

Inasmuch as claim 5 *called merely for a rocker, a tappet and a spring*, this claim showed that the inventor realized that his invention could be present in these elements alone regardless of what means might be used to move the tappet. This claim, confined to the basic elements, did not include a lever, a plunger, or any other kind of an operating member. If the defendant shows that this claim should not have been omitted when examining the original patent to determine the elements that were regarded as essential, then the evidence in claim 5 cannot be disregarded, and it cannot be held that *either* plungers or levers are essential to the invention. Infringement of claims 7 and 8 can then be established at once, for these claims, aside from the spring, call only for a tappet and a rocker with specific structural features that are admittedly present in the accused tuners. As to the infringement of claims 9, 10 and 11, the only additional element neces-

sary to find in plaintiffs' tuners is "a manually operable member", or a manually operable means". Plaintiffs' plunger is clearly such an element.

As indicated in footnote 7 of this court's prior decision, the idea of omitting claim 5 when considering the original patent, grew out of the Supreme Court decision in *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 491, 55 Ct. 455, which said that the disclaimer therein "speaks from the date of the original patent." Appellant's Opening Brief, pages 24 to 30, discussed certain phases of this matter under the heading "The Stated Objects as Well as Original Claim 5 Described the Invention Without Reference to Levers," and it was there pointed out that the patent sued upon in the *Altoona* case was not a reissue patent and that the Supreme Court merely meant the patentee's relinquishment of his monopoly to the disclaimed combination dated back to the original patent.

The Supreme Court did not say that a disclaimed claim could not be considered when examining an original and a reissue patent to determine whether they were for the same invention; in fact, it will be shown hereinafter that such an interpretation is contrary to the *Altoona* decision.

The idea that claim 5 should be omitted when comparing the two documents, did not originate with either of the litigants in the *Associated* case. It was not proposed in any of the briefs of opposing counsel. It was neither discussed nor suggested at the hearing in that case. The first time the idea was advanced anywhere was in the final opinion of this Court, which was thus rendered without the benefit of briefs upon this point from either side.

In the *Altoona* case, the Supreme Court considered whether claims 9 and 10 as modified by a qualifying disclaimer were for the same combinations set forth in the original claims. But in order to determine this, the Court compared the claims as altered by the disclaimer with the claims *as they appeared when the patent originally issued from the Patent Office*.

The Court did not first alter the original patent to take the disclaimer into account on the ground that the disclaimer speaks from the date of the original patent, and then compare the patent *as thus altered* with the patent as it later appeared after the disclaimer. Such a procedure would have rendered the comparison meaningless. It was absolutely essential for the Supreme Court to determine the patentee's intent with respect to the combination by considering the claims *just as the patent appeared when it was originally granted*.

The Supreme Court even made the latter method *mandatory* upon *itself* in the very last decision that it rendered upon the subject of disclaimers. This was the case of *Milcor Steel Co. v. George A. Fuller Co., et al.*, 316 U. S. 143, 62 S. Ct. 969, where the Court said at page 971:

"Limiting ourselves *as we must* to the *original claims* to determine the nature of the combination *covered by the patent* WHEN IT WAS GRANTED, and comparing that combination with the one purportedly embodied by the claims after the disclaimer, we can only conclude that the revised patent includes new elements which were not present in the original."
(Emphasis added.)

All through the *Altoona* decision, the Supreme Court makes its comparison on the basis of how the patent read "*when it was granted*" before the disclaimer had been filed. The following excerpts from the *Altoona* opinion are very illuminating in this regard:

At page 456:

"Claim 9, as originally allowed, was for the arcuate flexing of the record; claim 13 similarly was for a combination for a means for projecting a narrow line of light upon and through the moving film to a photoelectric cell in sound reproduction. A disclaimer, filed by respondent shortly before the trial, purports, in varying terms, to add the flywheel device to each of these claims."

At 459:

"The Court of Appeals, in upholding the patent, made no examination of its separate claims, but treated the patent throughout as though it were a combination of five distinct elements, the photoelectric cell, the arcuate flexing of the film, the flywheel, the flexible connection of flywheel, and the optical slit, although nowhere in the patent is any such combination claimed. The patent thus upheld is one which was neither claimed nor granted. Under the statute, it is the claims of the patent which define the invention." (Citing cases.)

At 460:

"* * * The patent as issued contained the following claims:"

(Claims 9 and 13 were then quoted).

“In 1933 respondents, by appropriate procedure, disclaimed:

“(b) The method as set forth in claim 9, excepting wherein”

“(c) The combination as set forth in claim 13, except wherein”

“While the effect of the disclaimer, if valid, was in one sense to narrow the claims, so as to cover the combinations *originally appearing in claims 9 and 13* only when used in conjunction with the flywheel, it also operated to add the flywheel as a new element to each of the combinations described in the claims * * *.”

At 461:

“A patent amended by disclaimer thus speaks from the date of the original patent *while the reissued patent, with respect to the amended claim, speaks from the date of the reissue.*” (Emphasis added.)

The *Milcor* and *Altoona* decisions, as previously pointed out, dealt specifically with disclaimers. The latter decision, as shown by the last quoted paragraph, is the very one in which the Supreme Court said “the disclaimer speaks from the date of the original patent”—the statement upon which this appellate court relied for its omission of original claim 5 when examining the original patent. Yet when the Supreme Court was trying to determine whether the patent *after the disclaimer* was for the same combination intended to be protected by the original claims, it carefully examined the original wording of the specific claims that were affected by the disclaimer.

With reissues, it isn't even necessary to be limited to the original claims in making the comparison, for the previously quoted *Harvie*, *Topliff* and *U. S. Chemical* de-

cisions all dealing with reissues, have laid particular stress upon the specification and the drawings. But when making a reissue comparison, the original patent must not first be altered to conform with later disclaimers, for the Supreme Court did not even do that in the *disclaimer* case in which it said that “the disclaimer speaks from the date of the original patent.” It is thus clear that this statement merely meant that the disclaimer speaks from the date of the original patent as far as the patentee’s monopoly is concerned.

That the disclaimer of claim 5 on January 16, 1939, could not possibly have any effect upon the validity of the reissue on August 16, 1938, may be further shown by a simple illustration. Suppose that claim 5 had not been disclaimed when this Court rendered its opinion in the *Associated* case. The Court would then have considered claim 5 when comparing the original and reissue claims, and it consequently could not have been said that “No leverless combination is disclosed or claimed in the original patent,” nor that “if the claims do not include levers, the claims are not for the same invention as the original patent and hence are invalid.” The validity of the reissue would therefore have been upheld. Then suppose that claim 5 was subsequently disclaimed. Would that mean that the reissue which had previously been held valid had now become invalid? If so, the validity of a reissue can never be finally determined, and the decision of the Commissioner of Patents, instead of having the finality attributed to it by this Honorable Court in the *Kitchen* case, *supra*, could be upset at any subsequent time merely by the disclaiming by the patentee of a broad reissue claim that had appeared in the original patent.

When the Commissioner of Patents acts upon the granting of a reissue, he has all the facts before him that can

have any possible bearing upon whether or not the re-issue is for the same invention as the original.

At this point it might be natural to inquire just what *was* the effect of the disclaimer of claim 5, and did it have any bearing at all upon the matters with which we are here concerned. The reason for the disclaimer of claim 5, and the net effect of the disclaimer, were explained in Appellant's Opening Brief, beginning with the last sentence on page 27 and extending to line 6 of page 30.

In the course of that explanation, the statement was made that claim 5 was discovered to read upon a device of the prior art. An illustration of that prior art device, and a consideration of its implications with respect to claim 5, might be further illuminating. The *Associated* record revealed that the said prior art device was the Marschalk tuner, shown and described in the Marschalk patent beginning on page 639 of Vol. III of the *Associated* record. The pertinent figure from this patent is here reproduced.

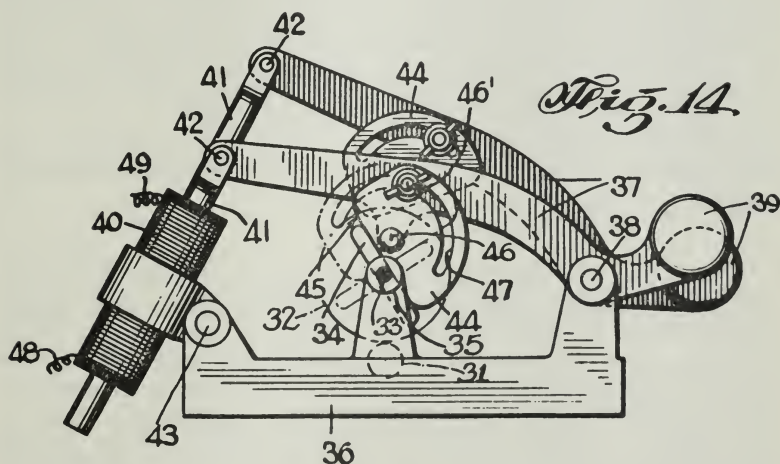


Fig. 14 from Marchalk patent.

Let us see how it responds to claim 5. [R. Vol. II, p. 170.]

“5. The combination with the tuning mechanism of a radio apparatus,”

The specification and other figures of the Marschalk patent showed that the Marchalk device was combined with such a tuning mechanism.

“of a rotatable rocker mounted upon a shaft operatively connected with said mechanism,”

Marschalk's rocker 34 was so connected.

“said rocker having two arms each extending on a different side of said shaft”;

The portions of a rocker, lever or rockshaft that lie on opposite sides of an axis, pivot or shaft are usually referred to as *arms*. So the *arms* in Marschalk are the parts of the rocker that lie on opposite sides of the shaft 33.

“means movable about a pivot and acting upon operation in one direction to slidably engage either arm of said rocker and push it in one direction to an angular position at which the movement of said rocker is arrested by the collision of said means and the oppositely moving other arm of said rocker”;

Marschalk's member 44 responds to this language in exact detail.¹

¹Marschalk refers to this member throughout his specification as a “plate.” A similar element, acting upon bars that move straight up and down, is called a “rocker” in the Schaefer patent, which appears in the *Associated* record beginning on page 586 of Vol. III. In the specification of the reissue patent here in suit it is called a “tappet,” but in plaintiffs' brief it is frequently referred to as a “cam.” To avoid possible confusion because of the various terms that one might select for this member, it is designated in claim 5 and some of the other claims of the reissue by the more descriptive term “means movable about a pivot,” accompanied by a recitation of what it does.

“and a spring for holding said means in a normally inoperative position.”

This, of course, is not present in the Marchalk tuner. It uses a weight 39 for this purpose. But the spring is a mere mechanical equivalent of a weight in moving the tappet *up*, just as a plunger is a mere mechanical equivalent of a lever for moving the tappet *down*. Since it makes no difference how the tapped is moved *up* or *down*, Leishman did not expect the courts would sustain claim 5, which was differentiated from the Marchalk device by the mere recitation of a spring instead of a weight. Claim 5 thus seemed clearly invalid, because it did not set forth any of the novel structural features of the rocker and tappet which distinguish the Leishman combination from that of Marschalk.

Some courts require that a claim be completely disclaimed or else modified by a qualifying disclaimer when it is discovered to be invalid. If a qualifying disclaimer had been filed, it would have been necessary that such disclaimer limit the claim to apply merely to rocker and tappet combinations in which these elements are constructed to permit the coaxial relationship when they are completely engaged. But claims 7 and 8 already covered such combinations: so claim 5 as thus modified would have been superfluous. It was consequently disclaimed in its entirety.

The disclaimer of claim 5 thus had nothing whatever to do with levers or plungers.

Claim 5, though later disclaimed, showed that Leishman did not regard either a lever or a plunger as essential to his invention. It mentioned neither.

It is significant that the plaintiffs have never made any attempt at any time to support the propriety of this Court's omission of claim 5 when it compared the original and reissue patents to determine whether they were for the same invention. They complain because the defendant disagrees with this Honorable Court's decision in the *Associated* case, but they make no attempt themselves to show that the former decision was correct. This was pointed out in footnote 10 of Appellant's Reply Brief, page 30, but the plaintiffs continued to ignore the matter at the hearing.

Claim 5 should clearly have been considered along with the other original claims when examining the original patent to determine the patentee's original intent.

As soon as this proposition is granted, infringement of claims 7 and 8 is at once established, for claim 5 showed that the operating member—whether a lever or a plunger—was not regarded as an essential element in the patentee's combinations. *No operating member was included as an element in this claim. Neither is an operating means included as an element in claims 7 and 8.* Aside from the spring, which is obviously present in plaintiffs' tuners, these claims call only for the rocker and the tappet. This Court found these elements present in the Crosley tuner involved in the *Associated* case. The plaintiffs do not challenge this, but assert that their tuners are the same as the tuner in the *Associated* case insofar as these claims are concerned.

Inasmuch as claim 5 defined a "leverless combination," it cannot properly be held that if the reissue claims do not include levers, the claims, are not for the same invention as the original patent." The reissue claims must be interpreted to mean just what they say.

(d) Irrespective of Claim 5, the Carnegie Steel Doctrine Requires That the Original Patent Be Construed as Contemplating Alternatives for the Levers in Moving the Tappets.

Appellant's Opening Brief quoted from *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, at page 437, in which the Supreme Court expounded the doctrine that "that which is common and well known is as if it were written out in the patent and delineated in the drawings."

Inasmuch as the new evidence has shown that plungers and levers were well known alternatives for operating automatic tuners and for moving tappets when the original patent was granted, the *Carnegie Steel* decision requires that the original patent be construed as if the use of a plunger for moving the tappet "were written out in the patent and delineated in the drawings." For this reason, irrespective of any other, it cannot be said that if the reissue claims "do not include levers, the claims are not for the same invention as the original patent."

Even if the original patent had contained no claim that did not include a lever, and even if the original objects had not used generic terms for the manually operable member, the foregoing Supreme Court rule will not permit it to be said that if the reissue claims "do not include levers, the claims are not for the same invention."

Although none of the claims at issue call for a specific kind of an operating member, they would nevertheless be infringed by the accused tuner even if every last claim specifically mentioned a lever, because the doctrine of equivalents or the *Carnegie Steel* doctrine would extend the meaning of the term to include all the known substitutes.

IV.

No Ground Remains to Support a Holding of
Non-Infringement.

In the *Associated* case, the present counsel based their defense against the charge of infringement upon the idea that the plungers and levers were not equivalents, and that the Crosley Corporation had done something so unprecedented in their use of direct push rods for automatic tuning that their device was lifted into a different class entirely.²

Now that this defense has been debunked by defendant's proof of the well known equivalency of plungers for levers in this art, opposing counsel have shifted their position and now incorrectly tell the court that it was of course admitted by both sides in the *Associated* case that the use of plungers was old in this art.

²The first evidence in the *Associated* case was taken by deposition in Cincinnati. It included the deposition of Lewis M. Crosley, vice-president of the Crosley Corporation. The following testimony of Mr. Crosley appears in this Court's record of that case, Vol. II, pages 329 and 330:

"Q19. Did you consider that you had anything exclusive in that tuning device for your company's products?"

"A. Yes.

"Q20. What was it?"

"A. We felt that we had overcome the objection to the types of tuning previously used, both manual and electrical, *because of a direct push rod acting to rotate the condenser.*" (Emphasis supplied.)

The contention that plunger-operated tuners were *not* old and that they were developed by the Crosley Corporation was reiterated right along in the present counsel's briefs in the *Associated* case. See the present counsel's previous statements quoted in footnote 4 of Appellant's Reply Brief in the present appeal, page 8.

Opposing counsel stuck to that same defense before the Supreme Court, and even erroneously asserted to the Supreme Court that this Court of Appeals and the District Court had made *concurrent*

Plaintiffs' present position with respect to infringement seems merely to be that the defendant is wrong in not interpreting his claims as limited to *lever*-operated devices. But it has been established, by evidence not previously before the court, that plaintiffs' plungers are equivalents of the levers shown in the patent. *It has now been shown by this brief that the claims are to be literally construed, and that they do not have to be limited to lever operation in order to be for the same invention as the original patent.* If plaintiffs' counsel repeat their previous strategy, when confronted with irrefutable evidence, of trying to make it appear that they never took a position contrary to such evidence, they will now say, "The fact that the reissue claims do not have to be confined to lever operation in order to be for the same invention as the original, was shown by the record in the Associated

findings that plungers and levers were not equivalents, whereas the fact is that the District Court never made any finding at all about equivalents nor anything else pertaining to the issue of infringement.

In Respondent's Brief in opposition to the Petition for Writ of Certiorari, counsel said on page 10:

"The Court of Appeals here held that levers and plungers are not equivalents, and this is complained of by Petitioner. There are many reasons why plungers are not the equivalent of levers . . ."

On the same page, respondent's brief further said:

"But in any case, concurrent findings by the District Court and the Court of Appeals that plungers and levers are not equivalents, give no basis for review by certiorari."

Counsel now piously tells this Appellate Court on page 34 of the Brief for Appellees:

"The fact that both plungers and levers had been used in radio tuners in the prior art was shown by the record in the Associated Wholesale Elec. case and conceded by both parties in that case."

Similar statements were made by Mr. Lyon at the hearing.

Wholesale Elec. case and conceded by both parties in that case.”

To what can they now turn? The defendant has gone through plaintiffs’ brief and can find only one other defense even hinted at. Plaintiffs’ brief tried to make it appear that the patent is concerned only with the simultaneous performance of two tuning operations, that the second rocker and tappet are essential elements in defendant’s combinations, and that this Court meant that infringement was avoided because the Crosley plunger did not move a second tappet.³ That none of these inferences is true was demonstrated in Appellant’s Reply Brief in the portions extending from the bottom of page 10 to the bottom of page 13, to which the Court is respectfully referred.

It was pointed out on page 11 of Appellant’s Reply Brief that the patent specifically pointed out that the invention was intended for tuning “*either a radio set or a television set, or both.*” (Emphasis added.)

None of the claims at issue call for the second rocker or the second tappet.

³This defense was not seriously urged, because plaintiffs stated on page 44 of their brief:

“The devices complained of herein are radio receivers only and have no associated television apparatus. We are concerned in this suit, therefore, *only with the portions of the mechanism of the patent in suit which are designed for tuning a radio receiver.*”

It was shown on page 13 of Appellant’s Reply Brief that opposing counsel have also said that we are not concerned with the second tappet and second rocker, and that the patent may be considered as consisting of *three* elements.

The remarks of Judge Learned Hand in the case of *Claude Neon Lights, Inc. v. E. L. Machlett & Son et al.*, 36 F. (2d) 574, 575, are pertinent here:

“* * * It is the claim which singles out from the complex disclosed those elements which constitute the ‘invention’, and substantially the whole work of the Patent Office lies in determining, not whether the disclosure is new because all of it never is, but whether the claims proposed are. Strictly the disclosure should be used therefore only as the setting of the claims and to find what the words employed really mean. Otherwise courts would have to assume the duties of the office afresh and compose such claims as the prior art might have allowed, had the patentee been farsighted enough to include all possible variants of his meaning. Such a result the decisions have repeatedly repudiated, and it would result in an intolerable burden upon the public, which would be charged not only with a knowledge of the prior art at the time of the application and often earlier, but with a right conclusion as to how much room was left for invention, seldom an easy question.”

The claims here at issue have *singled out* those elements and combinations which have to do with tuning a radio receiver, and the parts that are used for tuning a television receiver are consequently not included. It is the combinations set forth in these particular claims which therefore must be considered when determining infringement.

Had the plaintiffs thought that it was proper to omit claim 5 when examining the original patent to see whether the reissue was for the same invention, the plaintiffs might have urged that the original patent contained no

claim directed to a single rocker and tappet combination. But the plaintiffs have never advocated, nor even attempted to support, the idea that a disclaimed claim should be omitted from an original patent when examining it to determine the patentee's original intent.

When claim 5 is properly considered as a part of the original patent, it further supports the objects in proving *that the patentee intended right from the start that his tuner could be used with only one rocker and a single tappet.*

In determining infringement, each claim stands alone.

It might be well here to repeat one of the previously quoted paragraphs from the Supreme Court opinion in the *Altoona* case, *supra*. The following is from the Court's decision at page 459:

"The Court of Appeals, in upholding the patent, made no examination of its separate claims, but treated the patent throughout as though it were a combination of five distinct elements, the photo-electric cell, the arcuate flexing of the film, the flywheel, the flexible connection of the flywheel, and the optical slit, although nowhere in the patent is any such combination claimed. The patent thus upheld is one which was neither claimed nor granted. Under the statute, it is the claims of the patent which define the invention. (Citing cases.)"

When examining each claim individually, as shown in the previous briefs, it will be found that the operating member is not even included as an element in claims 7 and 8. These claims are confined to the tappet and rocker, constructed and arranged as shown in the drawings and described in the specification, *and as embodied in the accused tuners.*

The other claims call in addition for a manually movable operating means or members for moving the tappet. This of course can be either a plunger or lever or any other member that will perform this function.

Claims 7 and 8 were read upon the accused tuners on pages 22 and 23 of Appellant's Opening Brief, and claims 9, 10 and 11 were discussed on pages 48, 49 and 50.

No ground remains for withholding a decision that the claims are clearly infringed.

V.

Important Considerations Regarding Stare Decisis.

In their brief and also at the hearing the plaintiffs have urged that this Court's previous holdings should not be reconsidered. Although the earlier decision is not *res adjudicata* with respect to the present litigants, the plaintiffs urge at the bottom of page 27 of their brief: "The rule of law is not and should not be different with respect to the rights of different people or corporations. Uniformity of law is necessary to equal justice." That was a major thesis of counsel's remarks at the hearing.

What law shall be the standard? The law of the Ninth Circuit, or the law of the Tenth Circuit? The correct answer is not necessarily either: for if the law is in error, the principle of uniformity produces not equal justice, but equal injustice.

Plaintiffs' thesis clearly means that if a patent is once held invalid or not infringed, such ruling shall be considered as *res adjudicata* with respect to all other alleged infringers. That doctrine would nullify the rules of the Supreme Court that permit the issues of validity and infringement to be relitigated with respect to parties who

were not involved in the first suit. This rule was discussed in the decision in the case of *Triplett et al. v. Lowell et al.*, 297 U. S. 638, 56 S. Ct. 645, 648, cited on pages 49 and 50 of Appellant's Reply Brief.

The courts have repeatedly held that the doctrine of *stare decisis* shall not be used for the perpetuation of error. The Supreme Court has never hesitated to re-examine its old decisions and to render new opinions in conformity with more complete evidence, a wider investigation of the law, or a mere change of viewpoint even when the facts have been the same. American courts strive always for the more perfect justice.

In *Genesee Chief v. Fitzhugh*, 12 How. 443, 456, 13 L. Ed. 1058, 1064, the Supreme Court said:

"It is the decision in the case of *The Thomas Jefferson* which mainly embarrasses the court in the present inquiry. We are sensible of the great weight to which it is entitled. But at the same time we are convinced that, if we follow it, we follow an erroneous decision into which the court fell, when the great importance of the question as it now presents itself could not be foreseen; and the subject did not therefore receive the deliberate consideration which at this time would have been given to it by the eminent men who presided here when that case was decided."

The Supreme Court also reversed itself in the case of *United States v. Nice*, 241 U. S. 591, 601, 60 L. Ed. 1192, 1196, 36 Sup. Ct. Rep. 696:

"We recognize that a different construction was placed upon section 6 of the act of 1887 in *Re. Heff*,

197 U. S. 488, 49 L. ed. 848, 25 Sup. Ct. Rep. 506, but, after re-examining the question in the light of other provisions in the act, and of many later enactments, clearly reflecting what was intended by Congress, we are constrained to hold that the decision in that case is not well grounded, and it is accordingly overruled.”

The same striving for the more perfect justice appears in the Supreme Court case of *Boston Store of Chicago v. American Graphophone Company and Columbia Graphophone Company*, 246 U. S. 8, 25, 62 L. Ed. 551, 558, 38 Sup. Ct. Rep. 357, Ann. Cas. 1918C 447:

“In other words, it required once again a consideration of the doctrine which had been previously announced in *Henry v. A. B. Dick Co.* * * * Comprehensively reviewing the subject, it was decided that the rulings in *Bauer v. O’Connel* and *Straus v. Victor Talking Mach. Co.* conflicted with the doctrine announced and the rights sustained in *Henry v. A. B. Dick Co.* and that case was consequently overruled.”

In *T. J. Terral v. Burke Construction Company*, 257 U. S. 529, 533, 66 L. Ed. 352, 354, the Supreme Court said:

“It follows that the cases of *Doyle v. Continental Ins. Co.*, 94 U. S. 535, 24 L. ed. 148, and *Security Mut. L. Ins. Co. v. Prewitt*, 202 U. S. 246, 50 L. ed. 1013, 26 Sup. Ct. Rep. 619, 6 Ann. Cas. 317, must be considered as overruled, and that the views of the

minority judges in those cases have become the law of this court.”

In *Lee v. Chesapeake & O. R. Co.*, 260 U. S. 653, 659, 67 L. Ed. 443, 446, 447, the same statutory provisions were involved, and the facts were like those in a previous case, but the Supreme Court did not hesitate to render a different opinion.

“The plaintiff’s contention to the contrary is predicated largely on a decision by this court in *Ex parte Wisner*, 203 U. S. 449, 51 L. ed. 264, 27 Sup. Ct. Rep. 150, which, it must be conceded, is not in accord with the views expressed in this opinion. In that case the facts were like those here and the same statutory provisions were involved. * * * We had occasion to criticize it” [the *Wisner* opinion] “in *General Invest. Co. v. Lake Shore & M. S. R. Co.*, *supra*, and now, we feel constrained to pronounce it essentially unsound, and definitely to overrule it.”

This court should not hesitate to re-examine its old opinion in the *Associated* case. That such a re-examination may be in order is definitely indicated by the fact that the U. S. District Court for the West District of Oklahoma did not see fit to follow this Court’s former opinion notwithstanding the fact that it was strongly urged and the devices involved were admittedly the same insofar as the claims were concerned:

“The tuners referred to in Finding 26 do not differ in any essential respect, so far as the question of in-

fringement is concerned, from the tuner manufactured by Crosley Corporation of Cincinnati, Ohio, titled *Le-Roy J. Leishman v. Associated Wholesale Electric Co.*, tried in the Southern District of California and reported in 36 F. Supp. 804. *In said action, the Circuit Court of Appeals for the Ninth Circuit rendered its opinion, reported in 137 F. (2nd) 722.*" (Emphasis added.) Finding of fact 27, *Leishman v. The Richards & Conover Co.* See Vol. I of the present record, p. 59.

"7. The reissue patent No. 20,827, and especially claims 7, 8, 9, 10 and 11 thereof, are for the same invention as patent 2,108,538; and it appears, from the face of the said patent 2,108,538, that plaintiff intended to claim the invention now claimed by claims 7, 8, 9, 10 and 11 in the reissue patent No. 20,827.

8. The reissue patent No. 20,827 conforms in all respects with the requirements of Section 4916 of the Revised Statutes."

* * * * *

"11. The tappet or positioning element described in plaintiff's reissue patent No. 20,827 may be mounted either on a lever or a plunger to move the tappet, since a lever and a plunger perform their functions in the same way and are mechanical equivalents.

* * * * *

"16. The use of plungers for operating mechanical automatic tuners was known long prior to plaintiff's development of his patented structure set forth in the reissue patent in suit." [R. Vol. I, pp. 54, 55 and 56.]

“6. Claims 7, 8, 9, 10 and 11 of the reissue patent No. 20,827 are clearly valid, and clearly infringed due to the use of tuning devices in the following radio receiver sets manufactured by said Galvin Manufacturing Corporation and sold by defendant: Models 25F, 26C, 26C-7, 27D, 28-O, 30-P, 29-B, and 29B-6. This finding is made without any regard to any commercial success which plaintiff’s tuners have attained.”

* * * * *

“26. The infringing tuners sold by defendant are exemplified generally by the defendant’s exhibits G and H. These infringing devices were manufactured respectively by Radio Condenser Company and General Instrument Corporation, which are the joint plaintiffs in an action now pending in the District Court of the United States, Southern District of California, Central Division, and entitled: Radio Condenser Company and General Instrument Corporation v. LeRoy J. Leishman, No. 4395 B. H.” [R. Vol. I, pp. 53, 54 and 59.]

This Honorable Appellate Court, like the U. S. District Court for the Western District of Oklahoma, now has evidence before it that was not in the record of the *Associated* case. Furthermore, this court has now been briefed on pertinent legal points that were not discussed by counsel for either side in the *Associated* case either in the briefs or at the hearing. In accordance with the law and the evidence now before it, this Honorable Court should hold that the accused tuners are clear infringements of the claims here at issue.

VI.

The Plaintiffs Prepared the Defense in Oklahoma and Are Therefore Bound by the Oklahoma Judgment.

At the hearing on this appeal, plaintiffs' counsel incorrectly informed this Court that the defendant admits that all the plaintiffs did in Oklahoma was lend the Oklahoma defendant a couple of models. This statement was made in counsel's concluding remarks, and defendant therefore had no opportunity to rebut it. The truth is that the defendant has contended all along that the plaintiffs prepared the entire defense that was presented at the Oklahoma trial.

The plaintiffs studied the prior art, decided what the defense should be, designed models to illustrate that defense, built the models at their own expense, and furnished these specially constructed models to the trial attorney for the Oklahoma defendant at his request. The explanation and demonstration of these models constituted the entire defense that was presented at the Oklahoma trial. All this was brought out by the affidavit of plaintiffs' own attorney, Maxwell James, and by the portions of the Oklahoma trial transcript that were introduced in the present record and discussed in appellant's briefs.

Plaintiffs' insistence in their briefs that these models were not constructed especially for the Oklahoma trial, implies that the plaintiffs believe it might have made a difference if Mr. James, their patent attorney, had had them constructed after Attorney Mueller's request for help.

Plaintiffs' advance preparation was calculated to be *far more effective* and *far more to their advantage* as manufacturers in any action in which their tuners might become involved than any last minute action could possibly

have been. When the plaintiffs built the special trial models, they knew that if the models were successful in their purpose, no other defense would be necessary in any suit and that it would make no difference whether the claims were infringed or not.

Defendant's briefs have shown that an explanation and demonstration of these models was the only defense upon which *any* evidence was offered by the Oklahoma defendants.

Let us suppose for a moment that plaintiffs' special trial models had been successful in the purpose for which they were prepared and for which they were furnished to the Oklahoma defendant's attorney. Does anyone doubt that the plaintiffs here would have claimed they were entitled to the benefits of a favorable decision on the ground that they had prepared the defense? Had the present plaintiffs prevailed in their Oklahoma defense, there is certainly ample grounds in this Honorable Court's decisions in the *Anaconda*, *Hy-Lo*, and *National Nut Co.* cases to support a holding that the present plaintiffs were entitled to the benefits of such Oklahoma decision because of the nature of their participation.

As it is, the plaintiffs do not want to be bound—because their special trial models *backfired*.

Instead of holding that these special trial models established the case for the Oklahoma defendant, the court there made finding No. 20, which read:

"20. The structure of defendant's model, Exhibit M, is not a *correct* or *true* representation of the combined teachings of the Marschalk patent 2,072,897 and the Schaefer patent 1,906,106, but was made *after hindsight had shown the advantages of providing*

such a structure. Such a structure could not be arrived at by an ordinary mechanic skilled in the art prior to plaintiff's invention covered by claims 7, 8, 9, 10 and 11 of the reissue patent in suit." (Emphasis added.) [R. Vol. I, pp. 56 and 57.]

The defense prepared by the present plaintiffs, and upon which the Oklahoma defendant relied, thus *failed in its purpose*. The weapon that was especially designed and constructed to blast the Leishman patent, injured the plaintiffs' dealer instead. The plaintiffs should be made to take the consequences. They were accessories before the fact. Their misfortune that the wrong party was injured does not relieve them of the responsibility.

If the plaintiffs are not bound by the Oklahoma judgment, then the way has been opened for manufacturers to keep on participating in customers' suits until they somewhere obtain a favorable decision. All they will need to do is prepare the defense for the customer's attorney, embody it in special self-explanatory models, and supply the models to the customer.

It was clearly improper for the lower court to deny the defendant's motion for permission to make the defense that the plaintiffs were bound by the Oklahoma judgment, and it was a gross injustice for the lower court to render summary judgment against the defendant when he sought the opportunity to establish this defense by a full trial.

"It was error, therefore, on the part of the District Court to refuse to allow the plaintiffs to introduce the testimony offered in support of the issue of privity. Had plaintiffs prevailed on that issue, it would have been unnecessary to inquire into the validity of the patent or its infringement." *Carson Inv. Co. v. Anaconda Copper Mining Co.* (C. C. A. 9), 26 F. (2d) 651, 657.

The defendant contends that the evidence which he was able to produce in support of his motion for permission to amend the pleadings, was in and of itself sufficient to show that the plaintiffs should be bound by the Oklahoma judgment. There is every reason to believe that a trial could have brought out a great deal of additional evidence on this point.

What the Second Circuit Court of Appeals said in the case of *Arnstein v. Porter*, 154 F. (2d) 464, 471, is particularly applicable here:

“Illustrative of the dangers, in this respect, of summary judgment, if not cautiously employed, is a recent case in the court below. There the judge refused to grant summary judgment for defendants, despite a mass of impressive affidavits, containing copies of corporate records, the accuracy of which plaintiffs did not deny in their affidavits, and which on their face made plaintiffs’ case seem nothing but a sham; at the trial, however, cross-examination of the defendants revealed facts, theretofore unknown by plaintiffs, that so riddled the defendant’s case as it had previously appeared on the summary judgment motion that the judge entered judgment against them for several million dollars, from which they did not appeal.”

Should this case be remanded for a trial of the issue as to whether the plaintiffs are bound, or for a trial of any other issue, this Court should nevertheless hold that the plungers and levers are equivalents and that defendant’s combination may be operated by either of these well-known alternative means. Such a ruling will be helpful to the lower court in this case, as well as in another case about to be tried in this circuit. It will also avoid a likely, but unnecessary, conflict with the Tenth Circuit Court of Appeals.

VII.

If the Judgment Is Not Set Aside, the Seventh Paragraph of the Injunction Should Be Retained.

When plaintiffs' counsel was discussing this issue at the hearing, the Honorable Judge Bone inquired if it is not true that a suit against a customer is usually already pending when an injunction is issued in a manufacturer's suit restraining the patent owner from proceeding against the manufacturer's customers. That is, of course, true, but there is a great distinguishing difference here. In this instance, the injunction, which excepted the Oklahoma litigation from its operation, did not issue until the Oklahoma action had already been tried and a judgment had been entered in favor of the patentee. That was the first suit to determine the status of the present plaintiffs' tuners with respect to the patent here in suit. No injunction has ever issued at that stage of the game prohibiting the patentee from defending his judgment on appeal.

In the *Kessler v. Eldred* case, relied upon by the plaintiffs, there had been an earlier suit between the litigants in which it had been held that the manufacturer's device was not an infringement. This was *res adjudicata*. The suit against a customer which was stopped by the court, was brought subsequent to the entry of judgment in the manufacturer's favor in the much earlier action.

Other reasons supporting the seventh paragraph of the instant injunction will be apparent if a more complete answer is given to another question of the Honorable Judge Bone. This question, presented to plaintiffs' counsel, concerned the situation that would develop if both the Ninth and Tenth Circuit Courts of Appeals should affirm the conflicting judgments in their lower courts. It was asked if this would not create a situation in which Cir-

cuit Courts of Appeals would be blowing hot and cold upon the same subject.

The answer is *precisely*. But the Supreme Court has held that if one Circuit Court of Appeals blows cold upon a patent, the patentee has a right to see if he can get another Circuit Court of Appeals to blow hot. He has a right to an independent adjudication in another circuit. When this happens, the rules of the Supreme Court provide that it will resolve the conflict.

“Before the establishment of the Circuit Courts of Appeals, an adverse decision as to the validity of a patent in one circuit appears not to have foreclosed litigation of the same issue in another, see *Barbed Wire Patent*, 143 U. S. 275, 12 S. Ct. 443, 450, 36 L. Ed. 154; compare *United States v. American Bell Telephone Co.*, 128 U. S. 315, 372, 9 S. Ct. 90, 32 L. Ed. 450. *That it does not now is IMPLICITLY RECOGNIZED by the practice established under section 240 (a) of the Judicial Code, 28 U. S. C. A., §347 (a) and Rule 38 (5) of this Court (28 U. S. C. A. following section 354), that certiorari will not usually be granted in patent cases unless there is a conflict in the decisions of Circuit Courts of Appeals. We conclude that neither the rules of the common law applicable to successive litigations concerning the same subject-matter, nor the disclaimer statute, precludes relitigation of the validity of patent claims previously held invalid in a suit against a different defendant.*

“It follows that want of disclaimer of claims previously held invalid can never be set up as a bar *in limine* to the maintenance of a second suit upon those claims, and any others of the patent, since *the patentee is entitled to invoke in that suit the independent*

judgment of the court upon the validity of the claims which have been held invalid.” (Emphasis added.)

Triplett et al. v. Lowell et al., 297 U. S. 638, 56 S. Ct. 645 at 648.

In view of what is said in the foregoing decision, it should be clear that this court has no right to turn off defendant's water in another circuit.

If this court is concerned about the possibility of a conflict between its decision in the *Associated* case and a decision in the Tenth Circuit, the most appropriate thing to do would be to thoroughly re-examine the *Associated* decision in the light of the new evidence and the pertinent law, some of which has been cited for the first time in the present brief.

It is respectfully submitted that that kind of a critical analysis of the *Associated* decision, based upon the newly presented facts and a wider view of the law, will reveal that a new and different opinion should be rendered, as the Supreme Court has consistently done under similar circumstances.

Certainly this Honorable Court should not enjoin litigation in another circuit in order to avoid a possible conflict with its own previous opinions, nor should it prevent its previous opinions from being questioned in this circuit by affirming summary judgments based solely upon the doctrine of *stare decisis*. Such a course is precisely what the plaintiffs have proposed.

Respectfully submitted,

LEROY J. LEISHMAN,

Defendant-Appellant in Propria Persona.

UNITED STATES PATENT OFFICE

1,998,873

PROCESS FOR THE PRODUCTION OF
ETHYLENE OXIDE

Théodore Emile Lefort, Paris, France, assignor
to Société Anonyme; Société Française de
Catalyse Généralisée, Paris, France

No Drawing. Application March 22, 1932, Serial
No. 608,578. In France March 27, 1931

7 Claims. (Cl. 260-155.5)

This invention has for object a process for the production of ethylene oxide which mainly consists in subjecting ethylene to the simultaneous action of the oxygen of air and of water, in presence of a catalyst and, if need be, of hydrogen.

Hydrogen, in case it is employed, in contact with the catalyst, probably plays the part of an agent for accelerating the reaction which can be written as follows:



This reaction takes place at atmospheric pressure but, for commercially carrying the said process into practice, pressure can be employed, for instance a pressure of 50 kilograms per square centimeter, at a temperature between 150 and 400° C.

The following catalysts may be used:

- (1) A mixture of antimony, bismuth, silver, lead, arsenic, nickel and tin, in variable proportions.
- (2) Silver alone.
- (3) Silver activated by introducing therein small proportions of gold, copper or iron.
- (4) The metals: gold, copper, iron, separately or in admixture and in any proportions.
- (5) Silver alone, bismuth alone and antimony alone.
- (6) The following mixtures:

| | |
|---------------------------------|--------------------|
| Silver, gold, copper, iron..... | in any proportions |
| Silver, gold, copper..... | |
| Silver, gold..... | |
| Silver, copper, iron..... | |
| Silver, copper..... | |
| Silver, iron..... | |
| Copper, iron..... | |

(7) The mixtures of antimony, lead, nickel and silver.

(8) The mixtures of bismuth, nickel, silver and lead.

(9) The mixtures of antimony, bismuth, nickel.

(10) The mixtures of antimony, bismuth, silver.

(11) The mixtures of bismuth and nickel.

(12) The mixtures of bismuth and silver.

And, generally speaking, all the mixtures which can be obtained with the following metals:

antimony, lead, bismuth, silver, nickel, tin, arsenic, gold, copper, iron, taken separately, taken

two by two, three by three, four by four, etc., in variable proportions, the mixtures, in the same conditions, of these metals with their oxides, the mixtures of the oxides alone of these metals, in the same conditions.

The ethylene can be obtained from any source of supply: gas from coke ovens, hydrogenation of acetylene, dehydration of ethyl alcohol, and the like.

Water can be admitted in the reaction vessel, either in the liquid state, or as steam.

The oxygen can be the oxygen of the air, this latter gas being introduced into the reaction.

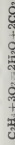
The efficiency of the reaction is increased by diminishing the CO_2 which is formed, by introduction in this reaction of a suitable quantity of water. A suitable volume of CO_2 can also be previously introduced in the reacting gases.

For increasing the yield in ethylene oxide, the process can also be carried out under a pressure lower than atmospheric pressure.

Experiments have shown that silver could be activated by introducing in this body small quantities either of gold or of copper or of iron.

Thus, a mixture containing silver, gold and iron gives very satisfactory results and at a low specific reaction; the only foreign product obtained in the reaction is CO_2 which can be easily removed. Aldehydes formed exist only as traces.

Moreover, the applicant has found that the reaction giving CO_2 is contrarily to previous belief, a reaction of oxidation independent from that giving ethylene oxide and from that giving aldehydes. From experiments effected by the applicant, it results that, if water is introduced in suitable quantity, the reaction is not only facilitated, as above stated, but, in addition, the reaction giving CO_2 probably by direct oxidation of ethylene according to the equation:



is checked, owing, as is probable, to the partial pressure of water. From these experiments, it can be concluded that if a certain quantity of CO_2 is previously introduced, in addition, in the reacting gases, the partial pressure of CO_2 will produce its effect, and the reaction of oxidation of ethylene into CO_2 will be completely checked.

resulting in a considerable increase in the efficiency of the operation. Moreover, it is to be noted that, when the synthetic operation is effected under partial vacuum, the yield in ethylene oxide is increased.

Several modi operandi for carrying the process

into practice, will be indicated hereinafter, by way of example only.

Modus operandi I

In a plant constructed for resisting to high pressure, ethylene on the one hand and air on the other hand, are separately compressed by means of suitable compressors.

The mixture of air and ethylene can also be compressed by taking the necessary precautions in order to avoid the risk of explosion.

These two gases will be led, together with hydrogen or not, into a reaction tube resisting to the pressure of several hundreds of kilograms, and heated, for instance, to a temperature above 200° C. This tube communicated moreover with a circulating pump allowing to introduce water under pressure.

The reaction will take place in this tube between ethylene, the oxygen of air, and water. By controlling the outputs, a continuous operation will be obtained. Ethylene oxide thus formed will be separated from the other gases, for instance, by condensation.

Modus operandi II

Silver in powder form, or in the form of a wire gauze, and placed or not on a support or carrier, is introduced in a tube, made for instance of silica, and, after the said tube has been heated to a temperature comprised between 150 and 400° C., a mixture of ethylene, air, water vapour, and hydrogen is caused to pass there-through. The proportion of hydrogen is about 5% of the total mixture. The ethylene oxide produced can be separated from the gases issuing from the tube.

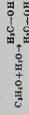
Modus operandi III

A silver colloid is introduced in a high pressure tube which has been filled with water. Pure ethylene under pressure is then added in order that it can dissolve in the water.

The tube is subsequently heated between 150 and 400° C., then air and hydrogen are slowly introduced. The introduction of air is stopped when the totality of ethylene is converted into ethylene oxide.

From ethylene oxide produced according to the processes which have been indicated above, it is possible to obtain, by simple saponification, ethylene-glycol, or by other known methods, any derivative of ethylene-glycol.

The reaction, for obtaining ethylene-glycol, can be written as follows:



The experiments effected by the applicant have shown that, in presence of the catalysts indicated hereafter, in the form of steam or not, considerably faster than the reaction assuring the production of ethylene oxide.

What I claim as my invention and desire to secure by Letters Patent is:

1. A process for the production of ethylene oxide, consisting in subjecting ethylene to the simultaneous action of oxygen and water, in presence of a catalyst, constituted by silver activated by introducing in the body small quantities of a metal selected from a group consisting of gold, copper, and iron, at a temperature between 150 and 400° C.

2. A process for the production of ethylene oxide, consisting in subjecting ethylene to the simultaneous action of the oxygen and water, in presence of a catalyst, constituted by a mixture of silver, gold, copper and iron, at a temperature between 150 and 400 degrees C.

3. A process for the production of ethylene oxide, consisting in subjecting ethylene to the simultaneous action of oxygen and water, in presence of a catalyst constituted by a mixture of silver and gold, at a temperature between 150 and 400° C.

4. A process for the production of ethylene oxide consisting in subjecting ethylene to the simultaneous action of oxygen and steam, in presence of a catalyst constituted by a metal selected from a group consisting of silver, gold, copper and iron, and hydrogen in the proportion of 5 per cent of the total volume, at a temperature between 150 and 400 degrees C., and at a pressure below atmospheric pressure.

5. A process for the production of ethylene oxide consisting in subjecting ethylene to the simultaneous action of oxygen and steam, in presence of a catalyst constituted by a metal selected from a group consisting of silver, gold, copper and iron, and hydrogen in the proportion of 5 per cent of the total volume, and CO₂, and at a pressure below atmospheric pressure.

6. A process for the production of ethylene oxide, consisting in subjecting ethylene to the simultaneous action of oxygen, steam and hydrogen in presence of a catalyst constituted by silver activated with small quantities of gold, at a temperature between 150 and 400 degrees C.

7. A process for the production of ethylene oxide, consisting in subjecting ethylene to the simultaneous action of oxygen, steam and hydrogen in presence of a catalyst constituted by silver activated with small quantities of a mixture of gold and copper, at a temperature between 150 and 400 degrees C.

THÉODORE EMILE LEFORT.

UNITED STATES PATENT OFFICE

20,370

PROCESS FOR THE PRODUCTION OF ETHYLENE OXIDE

Theodore Emile Lefort, Paris, France, assignor, by mesne assignments, to Carbide and Carbon Chemicals Corporation, New York, N. Y., a corporation of New York

No Drawing. Original No. 1,998,878, dated April 23, 1935, Serial No. 600,578, March 22, 1932, Application for reissue September 25, 1936, Serial No. 106,613, in France March 27, 1931

9 Claims. (Cl. 268-54)

This invention provides a specific and novel process for making ethylene oxide. It essentially consists in causing ethylene to combine directly with molecular oxygen at temperatures of about 150° to 400° C. in the presence of a surface catalyst which favors the production of ethylene to ethylene oxide under these conditions. The process can be carried out at atmospheric pressure, and it may also be conducted at pressures above or below atmospheric pressure.

This process is characterized by an entirely unique reaction in which the direct addition of a single oxygen atom to the ethylene molecule occurs without the formation of significant amounts of other oxygenated compounds such as aldehydes. This novel reaction may be expressed as:



and it is accompanied by complete oxidation of some of the ethylene to give carbon dioxide and water according to the equation:



Ethylene from any desired source may be used, including that obtained from coke oven gas, hydrogenation of acetylene, or dehydration of ethyl alcohol. The oxygen can be the oxygen of the air, and can conveniently be mixed with the ethylene prior to the reaction.

The oxidation of ethylene takes place with a giving off of heat, and it is, of course, desirable to maintain the temperature of the zone of reaction within the range specified. This can be facilitated by suitable dilution of the reaction gases, such as that accomplished by the use of carbon dioxide, and some water or carbon dioxide may be added that formed can be admitted to the mixture in the zone if desired. Hydrogen may be similarly added.

The process can be conveniently conducted by passing a mixture containing air and ethylene through a tube, for example, of silica or of a material capable of withstanding high pressures, within which is placed such a surface catalyst as one composed of silver in finely divided form, and which may be disposed within the tube on a supporting material, or in other known ways. The temperature of the reaction zone is maintained between about 150° and 400° C., for example, at about 200° C., and the issuing products from the tube contain ethylene oxide, carbon dioxide and water without objectionable aldehydes.

The ethylene oxide can be recovered in any suitable way, preferably in liquid form by condensation or solution. The surface catalyst is preferably silver as stated, but other metals such as bismuth and antimony may be used. Likewise oxides of these metals or mixtures containing these metals or their oxides may be used. Experiments have also indicated that the catalyst may be silver activated by the addition of small amounts of gold or copper or iron.

In any case, the ethylene and oxygen are thus reacted simultaneously at the temperatures set forth in the presence of a surface catalyst and of water, and the process is conducted to produce ethylene oxide as a direct product in substantial and economic amount. The ethylene oxide can be recovered by known methods, and it may be further reacted to form ethylene glycol or derivatives of ethylene glycol.

I claim:

1. A process for the production of ethylene oxide, consisting in subjecting ethylene to a simultaneous action of oxygen and water at a temperature between 150° and 400° C. in the presence of a catalyst composed of silver activated by small quantities of gold selected from a group consisting of silver, gold, copper and iron.

2. A process for the production of ethylene oxide, consisting in subjecting ethylene to a simultaneous action of the oxygen and water at a temperature between 150° and 400° C. in the presence of a catalyst composed of a mixture of silver, gold, copper and iron.

3. A process for the production of ethylene oxide, consisting in subjecting ethylene to the simultaneous action of oxygen and water at a temperature between 150° C. and 400° C. in the presence of a catalyst composed of a mixture of silver and gold.

4. A process for the production of ethylene oxide consisting in subjecting ethylene to a simultaneous action of oxygen and steam at a temperature between 150° and 400° C. and at a pressure below atmospheric pressure, in the presence of a catalyst composed of metal selected from a group consisting of silver, gold, copper and iron, and in the presence of hydrogen in the proportion of 5 per cent of the total volume.

5. A process for the production of ethylene oxide consisting in subjecting ethylene to the simultaneous action of oxygen and steam at a pressure below atmospheric pressure, in the presence of a catalyst composed of a metal selected from a group consisting of silver, gold, copper

and iron, and in the presence of hydrogen in the proportion of 5 per cent of the total volume, and of CO₂.

6. A process for the production of ethylene oxide consisting in subjecting ethylene to the simultaneous action of oxygen, steam and hydrogen at a temperature between 150° and 400° C. in the presence of a catalyst composed of silver activated with small quantities of gold.

7. A process for the production of ethylene oxide consisting in subjecting ethylene to the simultaneous action of oxygen, steam and hydrogen at a temperature between 150° and 400° C. in the presence of a catalyst composed of silver activated with small quantities of a mixture of gold and copper.

8. The process of making ethylene oxide by the direct chemical combination of oxygen with ethylene in the proportions of one atom of oxygen to one molecule of ethylene, which comprises forming a mixture containing ethylene and molecular oxygen and conducting said mixture through a confined reaction zone which is maintained at an elevated temperature; controlling said temperature to maintain said mixture in said zone at a temperature between about 150° and about 400° C.; subjecting said mixture in said zone at said elevated controlled temperature to intimate contact with an active surface catalyst of a material having the catalytic characteristics of silver which favors the direct oxidation of said ethylene in said mixture by said molecular oxygen to form oxidation products containing ethylene oxide in the presence of water and which does not favor the existence in said products of substantial amounts of aldehydes; correlating

the passage of said mixture through said reaction zone in the presence of said catalyst and the controlled elevated temperature of said mixture and said catalyst to effect said oxidation of said ethylene directly to form substantial amounts of ethylene oxide; and thereafter recovering ethylene oxide-containing product in liquid form.

9. The process of making ethylene oxide by the direct chemical combination of oxygen with ethylene in the proportions of one atom of oxygen to one molecule of ethylene, which comprises forming a mixture containing ethylene and molecular oxygen and a heat-absorbing diluent and conducting said mixture through a confined reaction zone which is maintained at an elevated temperature; controlling said temperature to maintain said mixture in said zone at a temperature between about 150° and about 400° C.; subjecting said mixture at said elevated controlled temperature to intimate contact with an active surface catalyst material composed essentially of silver which favors the direct oxidation of said ethylene in said mixture by said molecular oxygen to form oxidation products containing ethylene oxide in the presence of water and which does not favor the existence in said products of substantial amounts of aldehydes; correlating the passage of said mixture through said reaction zone in the presence of said catalyst and the controlled elevated temperature of said mixture and said catalyst to effect said oxidation of said ethylene directly to form substantial amounts of ethylene oxide; and thereafter separating ethylene oxide from the products of oxidation.

THEODORE EMILE LEFORT.

DISCLAIMER

Re. 20,370.—*Theodore Emile Lefort*, Paris, France. PROCESS FOR THE PRODUCTION OF ETHYLENE OXIDE. Patent dated May 18, 1937. Disclaimer filed May 14, 1942, by the assignee, *Carbide and Carbon Chemicals Corporation*.

Hereby disclaims claims 8 and 9 of said patent.

[*Official Gazette June 16, 1942.*]

